

REMARKS

In response to the Office Action mailed May 13, 2008, Applicant respectfully requests reconsideration. To further the prosecution of this application, amendments have been made in the claims, and each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 17-50, 59-74, 83-108 and 114-118 were previously pending in this application. Claims 17, 34, 59, 83, 100 and 114 are amended. No claims are added or canceled. As a result, claims 17-50, 59-74, 83-108 and 114-118 remain pending for examination, with claims 17, 34, 59, 83, 100, 107 and 114 being independent. No new matter has been added.

Claim Rejections Under 35 U.S.C. §103

Claims 17-50, 59-74, 83-108 and 114-118 are rejected under 35 U.S.C. §103(a) as purportedly being obvious over U.S. Patent No. 6,128,630 to Dent et al. ("Dent"). Each of independent claims 17, 34, 59, 83, 100, 107 and 114 is amended, and patentably distinguishes over Dent.

Initially, Applicant respectfully points out that the rejections are improper for a number of reasons discussed in the Pre-Appeal Brief Request for Review ("Request") filed November 13, 2008, the content of which is incorporated herein by reference. Specifically, in the Request, it was pointed out that the Office Action (1) fails to explain how each claim limitation is believed to be satisfied by the asserted reference, or the proposed modification to the asserted reference necessary to arrive at the claimed subject matter, as required under M.P.E.P. §706.02(j), (2) fails to answer all material previously traversed by Applicant, as required under M.P.E.P. §707.07(f), and (3) fails to cite all references relied upon in rejecting the claims, as required under M.P.E.P. §707.05. If the rejections are to be maintained, Applicant respectfully requests that the Office Action respond to each of these points.

A brief overview of embodiments of the invention and Dent, and a discussion of the manner in which each independent claim distinguishes over the prior art of record, follows.

I. Brief Overview of Embodiments of the Invention

Some embodiments of the invention provide a system for delivering information relating to financial transactions to investors via the Internet. By way of background, Applicant's specification explains that, conventionally, information relating to financial transactions was provided to investors in hard copy form (see, e.g., p. 1, line 13 – p. 2, line 8). The U.S. Securities And Exchange Commission (SEC) has now developed a set of compliance regulations for electronic delivery of financial information to investors, and these regulations require that the investor consent to having the information delivered electronically or maintained where the investor can access it (p. 3, lines 12-16).

Some embodiments of the invention provide a system which enables investors to consent to receive all or a portion of information relating to financial transactions electronically (p. 3, lines 16-17). A user may, for example, consent to electronic delivery of all types of financial information for all accounts, or to electronic delivery of only certain types of financial information for specific accounts, while continuing to receive paper-based notifications for other accounts and/or types of financial information (p. 6, lines 1-4).

The foregoing summary is provided to assist the Examiner in appreciating some aspects of the invention. However, this summary does not necessarily apply to each independent claim, and the language of each independent claim may differ in material respects from the examples described above. Thus, Applicant respectfully requests that the Examiner give careful consideration to the language of each independent claim and to address each on its own merits, without relying on the summary above. In this respect, Applicant does not rely upon the foregoing to distinguish any claim over the prior art, but rather relies only upon the remarks below.

II. Brief Overview of Dent

Dent discloses a consumer bill management and payment system configured to receive, analyze, manage and pay electronic bills received in association with a consumer's accounts over

the Internet (Abstract). The system includes a notification manager that detects when an electronic bill has been received and notifies the consumer (Abstract).

The notification manager may notify the consumer in any of several ways when a bill has arrived (col. 6, lines 9-10). For example, the notification manager may cause a pop-up notification box to be displayed when a bill arrives (col. 6, lines 10-11). Another technique involves waking up the user interface when a bill arrives, and yet another technique involves launching the application (col. 6, lines 22-32).

Dent discloses that the notification manager allows the consumer to specify a preference for non-electronic forms of notification (col. 6, lines 40-41). For example, the notification manager may allow the consumer to specify that he/she would like to be telephoned or sent a fax when a particular bill arrives instead of being notified electronically (col. 6, lines 45-47).

III. Independent Claims 17, 34, 59 and 83

Each of independent claims 17, 34, 59 and 83 includes limitations directed to receiving financial transaction data for a plurality of distinct financial transactions and determining a unique identifier for each distinct financial transaction. A determination is made, *for each of the plurality of distinct financial transactions as a function of its respective unique identifier*, whether an associated client has consented to receiving data for the financial transaction electronically. The determining comprises comparing the unique identifier to a collection of identifiers. If it is determined that the associated client has consented to receiving data for the financial transaction electronically, the data for the financial transaction is made available to the associated client electronically.

Each of amended claims 17, 34, 59 and 83 clearly distinguishes over Dent, as Dent says nothing at all relating to determining, for each of a plurality of distinct financial transactions, as a function of the transaction's unique identifier, whether an associated client has consented to receiving data for the financial transaction electronically. As such, Dent necessarily fails to disclose or suggest that the determining comprises comparing the unique identifier to a collection of

identifiers, or making the data for a financial transaction available to an associated client electronically if it is determined that the associated client has consented to receiving data for the financial transaction electronically.

The system of Dent is fundamentally very different than the subject matter of claims 17, 34, 59 and 83, as Dent discloses a system which allows a consumer to manage his/her *bills* (see, e.g., Abstract), while the claims relate to making financial *transaction* data available electronically. A bill is not a transaction - no exchange is occasioned by the issuance of a bill. While the payment of a bill may arguably be a transaction, the system features disclosed by Dent and cited by the Office Action do not relate to bill payment, but rather to notifying a consumer when a bill has been issued. These features thus have nothing to do with making financial *transaction* data available electronically.

Further, Dent discloses or suggests nothing relating to determining, *for each of a plurality of distinct financial transactions as a function of its respective unique identifier*, whether an associated client has consented to receiving data for the financial transaction electronically. In support of its contention that Dent satisfies all of the limitations of the pending claims, the Office Action cites a passage of Dent which discloses that the system allows the consumer to elect being notified using non-electronic means, such as telephone or fax, when a bill arrives (col. 6, lines 39-53). If the consumer elects this option, the system notifies the appropriate billing entity that the consumer would like to be notified in the specified non-electronic manner (col. 6, lines 49-51). This passage thus relates to the consumer specifying that they would not like to be notified electronically, and not to determining whether a client has consented to receiving data for the financial transaction electronically, as recited by each of claims 17, 34, 59 and 83. Even if one assumed for argument's sake that Dent disclosed determining whether a client has consented to receiving data electronically (and it does not), Dent says nothing at all about making such a determination for each of a plurality of distinct financial transactions as a function of its respective unique identifier, as recited by each of claims 17, 34, 59 and 83. Dent thus necessarily fails to disclose or suggest making this determination by comparing the unique identifier for each transaction to a collection of identifiers, as recited by each of claims 17, 34, 59 and 83.

As a result, each of independent claims 17, 34, 59 and 83 patentably distinguishes over Dent, such that the rejection of these claims, and of the claims that depend respectively therefrom, under 35 U.S.C. §103(a) as purportedly being obvious over Dent should be withdrawn.

IV. Independent Claim 100

As amended, independent claim 100 recites a method of providing financial transaction data for at least one financial transaction electronically to a user. The method comprises obtaining consent from the user to provide data for a particular type of financial transaction electronically; receiving information on a plurality of distinct financial transactions, each having a type; and if information for a financial transaction of the particular type is received, providing data for the financial transaction electronically to the user; wherein each financial transaction relates to an investment in a security or mutual fund.

In rejecting previously pending claim 100, the Office Action pointed to a passage of Dent (i.e., col. 6, lines 39-53) which discloses that a consumer may elect to be notified in non-electronic form when a bill arrives, such as by telephone or fax (col. 6, lines 39-53). As discussed above, this passage relates to bills and not transactions, and discloses a technique whereby a user may specify that he/she would not like to be notified electronically when a bill arrives, not to obtaining consent to provide data electronically, as required by claim 100. As a result, the cited passage necessarily does not relate to obtaining consent from the user to provide data *for a particular type* of financial transaction electronically, or providing data for a financial transaction electronically to the user if information *for a financial transaction of the particular type* is received, as required by claim 100.

Accordingly, claim 100 patentably distinguishes over Dent, such that the rejection of claim 100, and of the claims that depend therefrom, under 35 U.S.C. §103(a) as purportedly being unpatentable over Dent should be withdrawn.

V. Independent Claim 107

Claim 107 recites a method of obtaining and storing consent from a user to receive financial transaction data for at least one financial transaction electronically. The method comprises, *inter alia*, under control of a server system, receiving a consent message sent from a client system; and correlating the consent message to account information of a user and generating consented account information data.

In rejecting claim 107, the Office Action cites the same passage of Dent (i.e., col. 6, lines 39-53) discussed above which discloses that a consumer may elect to be notified in non-electronic form when a bill arrives (col. 6, lines 39-53). This passage simply says nothing about a server system receiving a consent message from a client system. Dent says nothing at all about a server system or consent messages, and thus necessarily fails to disclose or suggest correlating a consent message to account information of a user or generating consented account information data, as recited by claim 107.

Accordingly, claim 107 patentably distinguishes over Dent, such that the rejection of claim 107, and of the claims that depend therefrom, under 35 U.S.C. §103(a) as purportedly being obvious over Dent should be withdrawn.

VI. Independent Claim 114

As amended, claim 114 recites a method of sending financial transaction data electronically to a user. The method comprises, *inter alia*, receiving financial transaction data for at least one financial transaction, each financial transaction having a type and relating to an investment in a security or mutual fund; determining if an identified user has consented to receiving data for a particular type of financial transaction electronically; and when it has been determined that the user has consented to receiving data for the particular type of financial transaction electronically, sending data for the particular type of financial transaction electronically to the user.

It should be appreciated above from the discussion with respect to claim 100 that Dent fails to disclose or suggest determining if an identified user has consented to receiving data for a particular type of financial transaction electronically, or sending data for the particular type of

financial transaction electronically to the user when it has been determined that the user has consented to receiving data for the particular type of financial transaction electronically, as required by claim 114.

Accordingly, claim 114 patentably distinguishes over Dent, such that the rejection of claim 114, and of the claims that depend therefrom, under 35 U.S.C. §103(a) as purportedly being unpatentable over Dent should be withdrawn.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. N0389.70005US00.

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Respectfully submitted,

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